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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Group Art Unit: 3612

Robert M. Hunt

Examiner: Gutman, Hillary L.

Serial No.: 10/661,018

Filed: September 12, 2003

Confirmation No. 6819

For: Modular Base For Pickup Truck and Method of Assembly

Attorney Docket No.: GP-303369

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This is an appeal brief from the final rejection of claims of the Office Action mailed March 22, 2005. This application was filed on September 12, 2003.

Please charge the fee for filing this appeal brief, and any other fees that may be due, to Deposit Account 07-0960.

I. REAL PARTY IN INTEREST

The real party in interest is General Motors Corporation, a corporation organized and existing under the laws of the state of Delaware, and having a place of business at Detroit, Michigan.

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this paper, including all enclosures referred to herein, is being transmitted by facsimile addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 via fax number 571-273-6300 on:

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II. RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences related to the present appeal.

III. STATUS OF CLAIMS

Claims 1-19 are pending in this application. Claims 6-15 are withdrawn from consideration. Claims 1-5 and 16-19 are rejected. Claims 3 and 18 are the subject of this appeal.

IV. STATUS OF AMENDMENTS

An amendment after final rejection was filed on May 17, 2005, in which a limitation from claim 3 was added to independent claims 1 and 16, and to dependent claim 17. Claim 3 was cancelled, and claims 5 and 18 were amended to correct minor errors. The amendment was not entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Applicants' invention is recited both as an apparatus and a method. Claim 1 is directed to a pickup truck, which is shown at 20 in Figures 1-13 and addressed on page 4, line 10, in paragraph 0021 of the present application. The pickup truck includes a cab (shown at 24 in Figures 1-13, and addressed on page 4, line 11, in paragraph 0021 of the present application). The pickup truck also includes "a sidewall at least partially defining a pickup truck cargo box, the sidewall having a forward portion and a rearward portion with an elongated opening formed in the sidewall between the cab and the rearward portion."

Sidewalls in accordance with the claimed invention are shown at 44 in Figures 1-13 and are described on page 4, lines 13-18, in paragraphs 0021-0022 of the present application. A pickup truck cargo box is shown at 28 in Figure 1 and is described on page 4, lines 11-13, in paragraph 0021 of the present application. A forward portion of the sidewall is shown at 48 in Figure 1, and a rearward portion of the sidewall is shown at 52 in Figure 1; forward and rearward portions of the sidewall are described on page 4, lines 15 et seq., in paragraph 0022 of the present application. An elongated opening formed in the sidewall is shown at 60 in Figure 1, and is described on page 4, lines 17 et seq., in paragraph 0022 of the present application.

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Claim 1 further recites "at least one fastening element mounted with respect to the sidewall." Fastening elements are shown at 72 in Figure 1, and are described on page 4, lines 25 et seq., in paragraph 0023 of the present application. Claim 1 also recites that the at least one fastening element is "for mounting any one of a plurality of differently-configured sidewall modules at least partially within the elongated opening to provide or alter functionality of the sidewall." Differently configured sidewall modules in accordance with the invention are shown at 88A-88K in Figures 3-13, and the various sidewall module configurations are described from page 5, line 22 – page 9, line 13 (paragraphs 0026 – 0035).

Claim 3, which depends from claim 1, recites "wherein said opening is uncovered and upwardly open."

The invention provides increased flexibility in pickup truck functionality and appearance. A pickup truck of the invention functions as a modular base that may be configured in a multitude of ways with different sidewall modules. Thus, a single pickup truck design may form the base of a multitude of truck configurations, enabling a pickup truck manufacturer to realize economies of scale not possible with the prior art and to assemble trucks for niche markets that may not be otherwise profitable. Similarly, pickup truck users may own a single truck, but have the ability to add or alter functionality to their trucks by adding or changing sidewall modules.

Accordingly, independent claim 16 recites a method of advantageously using a pickup truck having the features recited in claim 1. Claim 16 recites "possessing a pickup truck" substantially as recited in claim 1, and "attaching a first sidewall module to the pickup truck such that the first sidewall module is at least partially within the first elongated opening." An exemplary first sidewall module is shown at 88B in Figure 4. Attaching a first sidewall module is described on page 5, line 22 et seq., in paragraph 0026 of the present application.

Claim 18, which depends from claim 16, recites "removing a second sidewall module from the first elongated opening prior to said attaching the first sidewall module, the second sidewall module being differently-structured and having a differently functionality from the first sidewall module." An exemplary second sidewall module is shown at 88A in Figure 3.

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Removing a sidewall module prior to attaching another sidewall module is described on page 6, lines 14-19, in paragraph 0027 of the present application.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claim 3 is rejected under 35 U.S.C. § 102(b) as being anticipated by Nelson et al. (U.S. Patent No. 4,126,349).

2. Claim 18 is rejected under 35 U.S.C. § 102(b) as being anticipated by Scott et al. (U.S. Patent No. 6,003,923).

VII. ARGUMENTS

i. Rejection of Claim 3 Under 35 U.S.C. § 102(b)

The Examiner rejected claim 3 under 35 U.S.C. § 102(b) as being anticipated by Nelson et al. Claim 3 depends from claim 1, and therefore includes all the elements and limitations of claim 1. Claim 1 recites, *inter alia*, “a sidewall at least partially defining a pickup truck cargo box, the sidewall having a forward portion and a rearward portion with an elongated opening formed in the sidewall ... and at least one fastening element ... for mounting any one of a plurality of differently-configured sidewall modules at least partially within the elongated opening to provide or alter functionality of the sidewall.” Claim 3 recites “wherein said opening is uncovered and upwardly open” (i.e., for receiving the sidewall modules or when the module is removed).

Nelson et al. teach a truck including “a pair of elongate and upright body side walls 11 and 12 which are oriented to extend longitudinally of the truck T at opposite sides thereof behind the cab.” Nelson et al., column 3, lines 35-38. The side walls 11, 12 of Nelson et al. include “a plurality of individual modules 18 in the form of cabinets.” Nelson et al., column 4, lines 10-11. As shown in Figure 1 of Nelson et al., side wall 11 includes modules 18a, 18c, and 18e, and side wall 12 includes modules 18b, 18d, and 18f. As shown in Figure 3 of Nelson et al., side wall 11 is entirely composed of modules 18a, 18c, and 18e. See also Nelson et al., column 4, lines 53-55 (“the modules ... define the entire body side walls 11 and 12 from top to bottom.”).

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For a rejection to be proper under 35 U.S.C. § 102, every element and limitation found in the rejected claim must be found in the § 102 reference. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See MPEP §2131.

The Examiner states that Nelson et al. "disclose a pickup truck comprising ... a sidewall at least partially defining a pickup truck cargo box, the sidewall having a forward portion and a rearward portion with an elongated opening (between 18a and 18e, Figure 6) formed in the sidewall ... and at least one fastening element 15, 16, 27 ... for mounting any one of a plurality of differently-configured sidewall modules 18c at least partially within the elongated opening.... With regard to claim 3, the opening is uncovered and upwardly open when module 18c is removed." (Office Action mailed March 22, 2005, page 4, lines 5-13) (emphasis added).

Thus, the Examiner relies on a modification of Nelson et al. to find anticipation of claim 3, that is, the Examiner relies on removal of module 18c in rejecting claim 3 under 35 U.S.C. § 102(b). However, in a rejection under 35 U.S.C. § 102, the prior art reference cited by the Examiner must describe each and every element and limitation of the rejected claim. *Verdegaal Bros.* Nelson et al. do not describe, expressly or inherently, the removal of module 18c. Furthermore, removal of module 18c is contrary to the express teaching of Nelson et al.

As noted *infra*, Nelson et al. describe the sidewall as being formed by modules 18a, 18c, and 18e. Nelson et al. further state that "In each of the truck body side walls, one of the ... modules has a wheel well formed in the lower portion thereof." Nelson et al., column 2, lines 42-44. (emphasis added). Module 18c is one of the modules that "has a wheel well formed in the lower portion thereof." Nelson et al., column 5, lines 6-7. Accordingly, if Nelson et al. teach that each of the truck body side walls has a module with a wheel well formed therein, and module 18c is the module that forms a wheel well, then Nelson et al. do not teach removing module 18c to form an opening that is upwardly open.

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Moreover, the manner in which the modules 18a, 18c, and 18e of Nelson et al. are attached to the truck T clearly shows that module 18c cannot be removed from the truck without also removing modules 18a and 18e:

The end walls 24 of adjacent modules 18 lie flush against each other and are secured together by fasteners such as bolts 25 extending through the plurality of aligned apertures 26 in the end walls 24. ... The recesses 27 in adjoining end walls 24 are located in confronting relation with each other as to define a socket receiving and capturing the end portion of the adjacent joist. ... In addition, the joists 15 are affixed to the end walls 24 at the recesses 27 by clamping fasteners such as bolts 30.

Nelson et al., column 4, lines 24-27, lines 35-38, and lines 49-50. With reference to Figure 8 of Nelson et al., the modules are attached to one another by fasteners 25 that extend through apertures 26 in the end walls 24 of adjacent modules, thereby to form side wall 11. The modules are then connected to the truck at joist 15 via bolts 30, each of the bolts 30 extending through the end walls 24 of adjacent modules 18a, 18c. Thus, module 18c cannot be removed without also removing modules 18a and 18e because the bolts 30 that connect module 18c to the truck also connect modules 18a and 18e to the truck.

Thus, Nelson teaches that the modules are connected to one another, and are connected to the truck in a manner that makes removal of module 18c, without also removing modules 18a and 18e, impossible without damaging the sidewall. Accordingly, module 18c is not removable without removing the entire sidewall, and therefore, the Examiner's statement that "the opening is uncovered and upwardly open when module 18c is removed" is contrary to the express teaching of Nelson et al. Nelson et al. clearly do not teach, expressly or inherently, removing module 18c, and therefore, the rejection of claim 3 is improper.

In an advisory action mailed June 2, 2005, the Examiner states that "the argument with respect to claim 3 and the Nelson reference is not found persuasive. Specifically, it is apparent from Figure 8 that the modules 18a and 18e can be attached to joists 15 with bolts 30

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without module 18c." However, the Examiner misconstrues the Applicant's argument. For a rejection under § 102, the issue is not whether it is *possible* to modify a reference to include all the limitations of a claim; rather the issue is whether the reference, without modification, describes all the elements and limitations of the claim. In the present case, the issue is not whether it is *possible* to assemble the side wall of Nelson et al. without the center module 18c; the issue is whether Nelson et al. describe the side wall without center module 18c.

Nelson et al. do not describe the side wall 11 with module 18c removed.

Therefore, Nelson et al. do not describe every element and limitation of claim 3. Applicants further note that the construction and assembly of the side wall 11 described by Nelson et al. does not contemplate the removal of module 18c; in other words, if the instructions for side wall assembly provided by Nelson et al. are followed, module 18c cannot be removed without also removing modules 18a and 18e. Removal of modules 18a and 18e would not result in an elongated opening formed in a sidewall, as recited by claim 3.

The Examiner thus relies on a *modification* to a cited reference to find the elements and limitations of claim 3, which Applicants submit is clearly improper for a finding of anticipation under 35 U.S.C. § 102(b). Accordingly, the rejection of claim 3 is improper.

Furthermore, there is no teaching in Nelson et al. that "a plurality of differently-configured sidewall modules" are mountable at the "at least one fastening element," as recited by claim 1. Rather, Nelson et al. teach only module 18c being mountable between modules 18a and 18e. Accordingly, claim 3 is not anticipated by Nelson et al.

ii. Rejection of Claim 3 Under 35 U.S.C. § 102(b)

Claim 18 depends from claim 16, which recites, *inter alia*, "possessing a pickup truck, the pickup truck including a cab and a first sidewall, ... a first elongated opening formed in the first sidewall ... and attaching a first sidewall module to the pickup truck such that the first sidewall module is at least partially within the first elongated opening." Claim 18 further recites "removing a second sidewall module from the first elongated opening prior to said attaching the first sidewall module, the second sidewall module being differently-structured and having a different[] functionality from the first sidewall module."

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In rejecting claims 16-18, the Examiner states that "Scott et al. inherently disclose a method of adding or altering pickup truck sidewall functionality ... comprising: possessing a pickup truck, ... and attaching a first sidewall module to the pickup truck ... ; [and] removing a second sidewall module from the first elongated opening prior to the step of attaching the first sidewall module, the second sidewall module being differently-structured and having a different functionality from the first sidewall module." (Office Action mailed March 22, 2005, page 3, line 3 – page 4, line 2).

The Examiner rejected claim 18 in a conclusory manner, and does not cite text or reference numbers from Scott et al. to support the rejection. Applicant respectfully submits that Scott et al. does not disclose, either expressly or inherently, the steps of removing a sidewall module from an elongated opening, and subsequently attaching another, structurally different sidewall module in the elongated opening, as recited by claims 16 and 18.

Applicant respectfully requested, in the Amendment filed May 17, 2005, that the Examiner cite text that expressly teaches the limitations of claim 18, or provide a basis in fact or technical reasoning to show that the limitations of claim 18 are necessarily present in Scott et al., as required for a finding of inherency. The Examiner did not address Applicant's argument in the advisory action mailed June 2, 2005.

VIII. SUMMARY

For the foregoing reasons, Applicant believes that the Examiner's rejections are erroneous, and reversal of the Examiner's rejections is respectfully requested.

Respectfully submitted,

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Date: September 21, 2005

Enclosure - Appendix

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IX. APPENDIX - CLAIMS ON APPEAL

1. A pickup truck comprising:
a cab;
a sidewall at least partially defining a pickup truck cargo box, the sidewall having a forward portion and a rearward portion with an elongated opening formed in the sidewall between the cab and the rearward portion; and
at least one fastening element mounted with respect to the sidewall for mounting any one of a plurality of differently-configured sidewall modules at least partially within the elongated opening to provide or alter functionality of the sidewall.
2. The pickup truck of claim 1, wherein said at least one fastening element faces the elongated opening.
3. The pickup truck of claim 1, wherein said at least one fastening element is a hole formed in the sidewall opening is uncovered and upwardly open.
4. The pickup truck of claim 1, wherein said at least one fastening element is configured for releasable engagement with a complementary fastening element on said any one of a plurality of differently-configured sidewall modules to enable module interchangeability.
5. The pickup truck of claim 1, wherein the elongated open extends from the forward portion to the rearward portion of the sidewall.
16. A method of adding or altering pickup truck sidewall functionality, the method comprising:
possessing a pickup truck, the pickup truck including a cab and a first sidewall, the first sidewall having a first forward portion and a first rearward portion with a first elongated opening formed in the first sidewall between the cab and the first rearward portion, and at least one a first fastening element mounted with respect to the first sidewall for mounting any one of a

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first plurality of differently-configured sidewall modules at least partially within the first elongated opening to provide or alter functionality of the first sidewall; and

attaching a first sidewall module to the pickup truck such that the first sidewall module is at least partially within the first elongated opening.

17. The method of claim 16, wherein the pickup truck has a second sidewall having a second forward portion and a second rearward portion with a second elongated opening formed in the second sidewall between the cab and the second rearward portion, and a second at least one fastening element mounted with respect to the second sidewall for mounting any one of a second plurality of differently-configured sidewall modules at least partially within the second elongated opening to provide or alter functionality of the second sidewall; and

wherein the method further comprises attaching a second sidewall module to the pickup truck such that the second sidewall module is at least partially within the second elongated opening; and

wherein the second sidewall module is differently-structured and has a different functionality from the first sidewall module.

18. The method of claim 16, further comprising removing a second sidewall module from the first elongated opening prior to said attaching the first sidewall module, the second sidewall module being differently-structured and having a differently functionality from the first sidewall module.

19. A pickup truck comprising:

a sidewall having a forward portion and a rearward portion with an elongated opening formed in the sidewall between the forward and rearward portions, the opening being uncovered and upwardly open; and

at least one fastening element facing the elongated opening and at which any one of a plurality of differently-configured sidewall modules is releasably mountable to provide or alter functionality of the sidewall.